UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,835	12/29/1999	GREGORY FENDIS	P06608US0/DE	2965

881 7590 06/15/2004

STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

EXAMINER	
MOSSER, ROBERT E	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/446,835	FENDIS, GREGORY	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 13-22, 29-38 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Colley*** or ***Born*** et al in view of ***Lobb*** et al (5,810,680).

Regarding claims 1-5, 13-22, 29-38 and 41-43, Colley or Born teach the limitations of the claims as discussed in the previous office actions (papers #12 and #15), incorporated herein by reference. Colley or Born are silent regarding the newly added claim features of the data input means being provided with respective location data indicative of a respective location thereof in terms of said phases so that said respective location data is available electronically to said respective data input means during the phase of said sport or game with which said respective data input means is associated without being entered during said sport or game and said system being configured to transmit progress data and respective location data of the data input means. Lobb teaches an input unit that has a GPS tracked input unit that has the feature of data input means is associated without being entered during said sport or game along with providing the respective location data indicative of a respective

location in terms of phases of play (abstract; Fig. 1; Fig. 2 and Fig. 2A and Fig. 5A). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include these features, as taught by Lobb, in the input means of Colley or Born to make the system more convenient for the user, whereby game play does not have to be interrupted to enter pertinent data. This would increase speed of play and make gaming more enjoyable.

Claims 6-12, 23-28 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Colley*** or ***Born*** et al in view of ***Lobb*** et al (5,810,680), further in view of ***Lyon***.

Regarding claims 6-12, 23-28 and 39-40, Colley or Born in view of Lobb teaches all the limitations of the claims as discussed above. The references lack the explicit disclosure of the data card and reader. However, as discussed in the previous office actions (papers #12 and #15), incorporated herein by reference, Lyon teaches this feature. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the similar golf score keeping teaching of Lyon encompassed on a smart card with the golf devices of Colley, Born and Lobb to make it easier for the users to store and keep track of their scores or alternatively provide the player with a portable copy of their golf statistics.

Examiner's Response to Applicant's Remarks

Applicant's arguments filed March 16th, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **Phases**) are not recited in the rejected claim(s) 17-40, 42 and 43. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993*). In the interest of furthering prosecution arguments directed to the feature of* ***Phases*** *have been understood to also encompass language similar to lines 2 through 6 of claim 31 as previously amended.*

Arguments directed to the "**phases**" and the equivalent provided for above are reliant on several assertions:

First, the applicant is correct in assuming the Lobb has been relied upon to provide the abilities to "transmit progress data and respective location data of the data input means" but only in combination with the previously stated "*without being entered during said sport or game*" as so claimed. However the features related to the location determination and game progress data separate from the "without being entered during a sports game" has been taught by figure 4 and the abstract of Colley. Wherein the abstract of Colley addresses that the transponders communicate with the closest terminal (shown to be present at each hole in figure 1) and thereby establishing the position locating means in association with each hole or **phase** of the game.

Second, the applicant has argued that the GPS location indicates the position of the player in Latitude and longitude but not in the phases of the game. As the teachings of Colley, Lobb, and Born all teach the use of their respective systems with the game of

golf and the specific stages/**phases**/holes of golf are implicitly fixed to a geographic location (I.e. Longitude and latitude), the play of the game is implicitly centered around the location (I.e. Longitude and latitude) each successive hole or **phase** of the game as so claimed. Similarly the correspondence between presenting the player with a positional location in relation to the hole that the player is on and the **phase** of the game are considered to be equivalents as it is well understood that a **phase** is equivalent to a hole in the game of golf regardless the number of holes or the ordered in which they are played.

Third, the applicant proposes that the "starting hole" of Lobb must be the first hole, however the examiner is unable to see any reference either directed to by the presented arguments or in the reference disclosure that would support this equation or limiting of scope. Further when one considers figure 5, Lobb refers to merely resetting his device to the "current hole " thus suggesting that the player is permitted to commence play on the hole of their discretion. However in view of the rejection previously recited the reliance of Lobb is provided solely for the features described above and the particular order of game play and operation of related features not presently claimed are set forth in the system of Colley, wherein the relationship of player and hole/**phase** of the game is determined by the transmitter associated with each hole/**phase** (ABS).

Fourth, based on the first three elements discussed the applicant contends that the combination of the Colley, Lobb, and Born references are insufficient to define the claimed invention based on the three points presented and addressed above. As each

of these points has been addressed this argument is held to satisfied by the combination of at least the three points presented.

Fifth, while the examiner concedes that Lobb does not teach the transmission of data during the progress of a game, however when considered in light of Colley (Col 1:52-60) and the fact that it is only the location feature of Lobb relied upon this point is satisfied by the combination.

As such the arguments focused on the **phase** and related features as presented are held non-persuasive.

The applicant argues that the teachings of Lyon and Lobb are in contradiction and so form a destructive combination as understood. The applicant holds that while Lyon provides a recording means utilizing a smart card the invention of Lobb utilizes a server system for a recording means. This examiner disagrees that the addition of a second memory means (such as the inclusion of both systems for the purposes of creating a back-up or private copy of game data) is specifically taught against or would in anyway create a destructive combination in their present form. To further this point neither, Lyon nor Lobb present any cause as to why one would not employ the other's system as would be required to establish a destructive combination. In addition to this, the features relied upon in the Lobb reference do not necessitate the inclusion of the server memory for combination with the system of Colley/Born. As presented the arguments challenging the combination of the Lyon and Lobb/Colley/Born references are held as non-persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

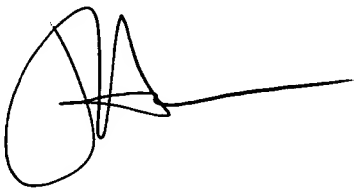
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



JESSICA HARRISON
PRIMARY EXAMINER